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EXAMINER

CRONIN, STEPHEN K

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Please find below and/or attached an Office communication concerning this application or proceeding.

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 16

Application Number: 09/608,985

Filing Date: June 30, 2000

Appellant(s): LAATS ET AL.

Jonathan E. Jobe, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 15, 2002.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3-10, 12 and 16-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

1,100,389	Miller	6-1914
4,664,533	Wollman	5-1987

(10) *Grounds of Rejection*

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The following ground(s) of rejection are applicable to the appealed claims:

As a precursor to the rejection of the claims under 35 USC 112 1st pg and for a better understand and clarify the reasons for the rejection, the objections to the specification and drawings are set forth below.

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 31, 2000 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the loop structure, the configuration and location of the aperture, and the configuration and location of the protrusion as is proposed in new figures 9 and 10 and the connection of the device to the strap as is proposed in new figure 11. Applicant's proposal of new figures 9 and 10 is clearly speculative based on the very broad disclosure as originally filed. For example, the protrusion could extend upward from the bottom portion of the loop proximate reference character 70 in figure 10 and protrude through mating apertures in the overlapping strap portions or the protrusion may extend horizontally from the strap portion 110 and through an aperture in the loop. Furthermore, the protrusion and aperture may be configured substantially different than that now proposed by applicant (see, for example, Miller reference applied hereinafter). Applicant clearly has no support in the originally filed application for the proposed illustrations and any proposals to illustrate the claimed subject matter by applicant will be held as introducing new matter. Accordingly, the drawings as originally filed are subject to examination in this Office action. As will be discussed below,

applicant's substitute specification has not been entered as a means to reduce confusion in the application.

The amendment filed in the form of a substitute specification is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. As discussed above, the proposed drawing corrections clearly introduce new matter. The material proposed in the substitute specification which is not supported by the original disclosure is that which makes reference to the proposed drawing corrections which have not been entered. As a means to reduce confusion in the application, the substitute specification filed August 31, 2001 has not been entered and the specification as originally filed is subject to examination.

Claims 1, 3-10, 12, and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

As discussed above, applicant merely broadly describes an inventive concept without providing clear illustration as to what is intended. One of ordinary skill in the art must clearly speculate as to what applicant considers as the invention. Accordingly, applicant's invention was not clearly described in a manner which would allow the ordinary artisan to make and use applicant's invention since the ordinary artisan can not readily determine what is applicant's invention.

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Claims 6-10, 16, 17, and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 6, the amended language "at least one of the following" allows more than one of the listed devices to be provided on the strap. The use of more than one device on the strap is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 16, the amended language "at least one of the following" allows the strap to be formed by a material having two or more of the materials listed. A material having two of more of the listed materials is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 19, applicant fails to claim a securing mechanism in addition to the loops. Applicant's disclosure as originally filed does not provide support for this now claimed broad subject matter. Applicant's claims may be no broader than the supporting disclosure. A narrow disclosure will limit claim breadth.

Claims 1, 3-10, 12, and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed above in detail, applicant has merely set forth an invention concept without providing clear means as to how this accomplished. One must speculate as to what applicant considers as the invention thereby rendering each of applicant's claims indefinite.

Each of the above mentioned claimed are further unclear in light of applicant's arguments provided at page 12, lines 3 et seq. Applicant states that the Swallow reference is not analogous to applicant's present invention. Applicant is invited to read the originally filed disclosure at page 2, line 25 through page 3, line 9 which clearly allows a device such as that found in Swallow. It is unclear on what grounds applicant may provide this "not analogous" argument since there is clearly no basis for this argument. In light of this argument, however, it raises doubt as to what applicant now considers as the invention. Accordingly, this rejection is applied.

Claims 1, 3, 5-10, and 19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Miller.

Regarding claim 1, the Miller reference discloses a strap (1) having a first strap end (see proximate lead line 14 in figure 2) a securing mechanism (see lead lines 3 and 4 in figure 2) as claimed, and a retention loop (see lead line 7 in figure 1; see also figure 4) wherein the loop "can" slide by releasing/pushing on element 19 (see figure 3). The

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retention loop having a protruding member (see lead line 13) which mates with an aperture (see lead line 2, page 1, lines 85 and 86, and figure 3 in Miller) as claimed.

Regarding claim 5, the strap is "configured" to receive a device thereon if so desired (see MPEP 2111). Applicant is not claiming the device. See also claims 6-10.

Claims 4, 16, and 17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller.

Regarding claim 4, although the protruding member is not on the strap and the aperture is not on the loop, it would have been an obvious matter of design choice to locate these parts as claimed, since applicant's specification is silent that this particular claimed feature solves any problems or is for any particular purpose (see page 4, lines 10 and 11 of applicant's disclosure as originally filed) and it would appear that the protrusion and aperture being located on the loop and strap, respectively, would perform equally as well on the Miller device.

Regarding claim 16, although the flexible strap in Miller is not formed from a material as claimed (see Miller at page 1, lines 79 et seq.), it would have been an obvious matter of design choice to form the strap of the claimed material, since applicant's specification is silent that this particular claimed feature solves any problems or is for any particular purpose (see page 3, lines 10-13 of applicant's originally filed disclosure) and it would appear that the strap being formed of woven metallic strands would perform equally as well on the Miller device.

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Claims 12 and 18, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Wollman.

Regarding claim 12, although it is unclear if the Miller device includes a device thereon, attention is directed to the Wollman reference which discloses another bracelet (see lead lines 11 and 12) which have a watch case (W) attached thereto. It would have been obvious, if not already, to one having ordinary skill in the art at the time the invention was made to modify the bracelet in Miller to accept a watch case as, for example, illustrated in Wollman in order to increase the utility of the Miller device to be worn as a watch band/bracelet.

(11) Response to Argument

In response to applicant's arguments directed to the objection to and the non-entry of the substitute specification and newly added figures 9-11 and the rejection of claims 1, 3-10, 12 and 16-19 under 35 USC 112 1st pg, the following is submitted. The originally filed specification and drawings must fully support any claimed invention. As pointed out in the office action mailed May 14, 2001 (paper number 4) the specification and drawings fail to fully support the claimed invention. Although the specification and drawings may be amended to clarify the disclosed invention, the specification and drawings cannot be amended to add material or specifics which were not present as originally filed. Newly submitted figures 9-11 lack any support in the drawings as originally filed. The specification as originally filed does not fully support the specifics of or location of the structure as set forth in newly submitted figures 9-11. The specification also references broadly many different types of straps upon which the disclosed retention device may be used which have structural variations different from

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those depicted by newly added figures 9-11. In view of this, one of ordinary skill in the art would be confused as to exactly what applicant's invention was and/or as to how to implement his invention on the numerous types of straps which applicant identifies as being able to support his retention device.

In response to applicant's arguments directed to the rejection of claims 1, 3-10, 12 and 16-19 under 35 USC 112 2nd pg, the rejection was applied in view of the comments set forth in the response to the first office action (paper number 6).

Applicant's view of the breadth of the claims is substantially narrower than that which is set forth in the claims. The examiner is therefore unclear as to whether applicant has sufficiently set forth and distinctly claimed what applicant considers as his invention.


In response to applicant's arguments directed to the deficiency of the Miller reference in the rejection of the claims under 35 USC 102(b) and 35 USC 103(a), the following is submitted. Applicant argues that the yoke frame of Miller does not meet the limitation of the claimed retention loop in that it cannot slide along the strap when the securing mechanism is not engaged. This cannot be the case. Otherwise the strap would be unable to be removed from the yoke and would always be secured as shown in figure 2 of Miller. When element 19 is depressed and securing mechanism 3, 4, is disengaged, strap end 5 of Miller will freely slide in and out of yoke 7. As to applicants other arguments directed to the Miller reference, the structure of Miller which meets the structure set forth in the claims has been clearly pointed out in the rejections above. Miller also appears to function in a manner which is equivalent the functional recitation set forth in the claims. It is further noted however that in a rejection of claims under 35 USC 102(b), such as applied to claims 1, 3, 5-10 and 19, it is not necessary for the prior

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art to function in the manner as claimed, only that the structure set forth in the claim be met by the prior art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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skc

January 10, 2003

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